

REMARKS

The Response

Claims 1, 5, 8-12, 20-28, and 30 are pending.

Rejection Under §102

Claims 1, 8-11, and 20-28 have been rejected under 35 U.S.C. §102(b) for allegedly being anticipated by J.M. Gomez-Vega et al., "A multilayer approach to fabricate bioactive glass coatings on Ti alloys", presented at the Materials Research Society (MRS) 1998 Fall Meeting on December 1, 1998 (hereinafter "the December 1, 1998 presentation") or alternately the paper entitled "A multilayer approach to fabricate bioactive glass coatings on Ti alloys" available via Lawrence Berkeley National Laboratory (hereinafter "the LBNL paper"). Applicants respectfully disagree with the Examiner and traverse this rejection in that neither are prior art under 35 U.S.C. §102(b).

MPEP 2128.01 IV. states: "As stated in *In re Klopfenstein*, 380 F.3d 1345, 1348, 72 USPQ2d 1117, 1119 (Fed. Cir. 2004), "the key inquiry is whether or not a reference has been made 'publicly accessible.'" Prior to the critical date, a fourteen-slide presentation disclosing the invention was printed and pasted onto poster boards. The printed slide presentation was displayed with no confidentiality restrictions for approximately three cumulative days at two different industry events. 380 F.3d at 1347, 72 USPQ2d at 1118. The court noted that "an entirely oral presentation that includes neither slides nor copies of the presentation is without question not a 'printed publication' for the purposes of 35 U.S.C. § 102(b). Furthermore, a presentation that includes a transient display of slides is likewise not necessarily a 'printed publication.'" 380 F.3d at 1349 n.4, 72 USPQ2d at 1122 n.4. In resolving whether or not a temporarily displayed reference that was neither distributed nor indexed was nonetheless made sufficiently publicly accessible to count as a "printed publication" under 35 U.S.C. 102(b), the court considered the following factors: "the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied."

380 F.3d at 1350, 72 USPQ2d at 1120." (emphases added).

The December 1, 1998 presentation

Regarding the issue whether the December 1, 1998 presentation is a "printed publication" under 35 U.S.C. §102(b), the Examiner alleges that: "Typically, during a presentation is usually accompanied with a power point presentation or similar visual display of the information associated with the talk." (page 7; emphases added).

Applicants respectfully point out that there is nothing in the record to indicate that there was any "power point presentation or similar visual display" used in this specific presentation. The Examiner's reliance on what is "typical" or "usual" does not sufficiently establish that a "power point presentation or similar visual display" actually took place.

Further, the Examiner alleges that: "As such, the talk can be reasonably considered to be a "slide presentation" similar to the situation in *In re Klopfenstein*." (page 7). If even the December 1, 1998 presentation included an alleged "slide presentation", it is distinguished from the *In re Klopfenstein* presentation. This is because the *In re Klopfenstein* presentation was "approximately three cumulative days" long, while in contrast the December 1, 1998 presentation was for only 15 minutes (3:30 p.m. to 3:45 p.m. according to the MRS conference schedule). Each slide displayed in a 15-minute slide presentation (where there is more than one slide) is necessarily exhibited for a length of time less than 15 minutes. A less than 15 minute exhibition must surely be transient. As such, Applicants respectfully contend that the 15- minute December 1, 1998 presentation does not constitute a "printed publication" to this present application under 35 U.S.C. §102(b).

Accordingly, Applicants respectfully contend that the 15 minute long December 1, 1998 presentation does not constitute a "printed publication" to this present application under 35 U.S.C. §102(b).

The LBNL paper

Applicants submit a further Declaration under 37 C.F.R. § 1.132 by Ms. Jean Wolslegel, the Reports Coordinator of Lawrence Berkeley National Laboratory Library, declaring that the earliest possible date the library first made the LBNL paper available to the public is October 9, 2001. Ms. Wolslegel also clarifies that: "The LBNL Library

does not necessarily use the term “Publication Date” to indicate when a paper is first made available to the public.” Having a publication date on or after October 9, 2001 means that the LBNL paper is not a prior art to this present application under 35 U.S.C. §102(b), since the present application has a priority date of May 1, 2000.

Since none of the cited papers are prior art under 35 U.S.C. §102(b), the Applicants respectfully request the Examiner to withdraw this rejection.

Rejection Under §103

Claims 5, 12, and 30 have been rejected under 35 U.S.C. §103(a) for allegedly being rendered obvious by the December 1, 1998 presentation or alternately the LBNL paper, in view of Gomez-Vega et al., “Novel Bioactive Functionally Graded Coatings on Ti6A14V” Advanced Materials 12(12): 894-897 (2000). Applicants respectfully disagree with the Examiner and traverse this rejection.

Claims 5, 12, and 30 are directed to a multilayer article comprising: a metal substrate, a first layer comprising an inner and outer surface, said first layer comprising a glass composition, a first intermediate layer having an inner and outer surface, and said first intermediate layer is located between the substrate and the first layer.

For the reasons provided earlier, both the December 1, 1998 presentation and the LBNL paper are not prior art.

The remaining disclosure, Gomez-Vega et al., “Novel Bioactive Functionally Graded Coatings on Ti6A14V” Advanced Materials 12(12): 894-897 (2000), alone does not teach or suggest a multilayer article comprising: a metal substrate, a first layer comprising an inner and outer surface, said first layer comprising a glass composition, a first intermediate layer having an inner and outer surface, and said first intermediate layer is located between the substrate and the first layer.

Accordingly, the cited papers fail to render Claims 5, 12, and 30 obvious under 35 U.S.C. §103(a). As such, the Applicants respectfully request the Examiner to withdraw this rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that all of the

claims are in condition for allowance, which action is requested. If in the opinion of the Examiner, a telephonic conference would expedite the prosecution of the subject application, Applicants encourage the Examiner to call the undersigned at (510) 486-4534.

If any fee is required to maintain pendency of this application, the Commissioner is authorized to charge any necessary and additional fees, including fees for additional extensions of time, that may be due to Deposit Account No. 120690, referencing Attorney Docket: IB-1627.

Respectfully submitted,

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